REMARKS

Claims 1-29 are pending with claims 1 and 20 being independent. Claims 1, 11, 16-18, and 20 have been amended, and claims 25-29 have been added. Applicants respectfully request reconsideration in light of the amendments and the following remarks.

35 U.S.C. §§ 102(e)/103(a) Yen and Yen/Bournas Rejections

Claims 1, 2, 4, 5, 7, 10, 18, 20, 22, and 24 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Yen (U.S. Patent No. 5,991,799). Claims 21 and 23 have been rejected under 35 U.S.C. § 103(a) as being obvious over Yen. Claims 11, 13, and 17 have been rejected under 35 U.S.C. § 103(a) as being obvious over Yen in view of Bournas (U.S. Patent No. 6,061,679). For at least the following reasons, Applicants respectfully request withdrawal of these rejections.

Independent claim 1 relates to a method of providing content relevant to television programming by determining context information associated with the television programming. As amended, claim 1 recites, among other things, "making an intelligent selection of selected context information from among the available context information, wherein making an intelligent selection comprises selecting the selected context information based upon a hierarchy of the available context information" (emphasis added). Claim 1 is patentable over Yen and Bournas because: (1) Yen and Bournas, alone or in combination, fail to describe or suggest at least this feature of claim 1, and (2) there is no motivation to combine Yen and Bournas.

With respect to reason (1), Yen fails to describe or suggest at least the claimed "making an intelligent selection [by] selecting the selected context information based upon a hierarchy of the available context information." Yen relates to a system for receiving incoming information items from multiple information sources and presenting one or more of those information items to a viewer. (Yen at col. 3, lines 6-9). The system includes a "background" element that interacts with the information sources to determine which information items may be of interest to the viewer and transmits those information items to a "foreground" element for display to the viewer. (Id. at col. 3, lines 10-25). Each information item is crosslinked to reference other information items from the same or other sources. (Id. at col. 8, lines 57-65). Based on the

degree of relatedness between information items, the background element determines which information items to transmit to the foreground element for display. (Id. at col. 9, lines 13-35). However, as acknowledged in the Office Action, Yen fails to describe or suggest the information items (which the Office Action equates to the claimed context information) being selected "based upon a hierarchy of the available context information," as now recited in claim 1. (See Office Action, at page 9, which states "Yen ... fail[s] to disclose making an intelligent selection compris[ing] selecting content information based upon a predetermined hierarchy.").

To meet the "hierarchy" feature of claim 1, the Office Action turns to Bournas. Applicants respectfully submit that Bournas fails to meet this limitation, primarily for the following reasons. Specifically, Bournas fails to describe or suggest at least "making an intelligent selection [by] selecting the selected context information based upon a hierarchy of the available context information." Bournas relates to a data structure and search technique that orders a plurality of sub-data structures based on ranges of key masks (e.g., IP addresses) associated with the sub-data structures. (Bournas at col. 1, lines 58-65). The data structure is described as being used for routing computer network or internet communications. (Id. at col. 4, lines 45-60). However, Bournas does not describe or suggest the claimed "selecting the selected context information" associated with television programming "based upon a hierarchy of the available context information," as recited in claim 1. Rather, as acknowledged on page 9 of the Office Action, Bournas discloses searching for or routing data in a data structure.

Because neither Yen nor Bournas describe or suggest at least the claimed "making an intelligent selection [by] selecting the context information based upon a hierarchy," claim 1 is not anticipated by Yen or obvious over Yen, Bournas, or any combination thereof.

With respect to reason (2), independent of and in addition to reason (1), there is no motivation or suggestion to combine the teachings of Yen and Bournas as proposed in the Office Action. Yen and Bournas relate to different technologies used to solve unrelated problems. Yen relates to a system for monitoring television programming being displayed in a foreground and determining which of multiple incoming information items to display over the television programming, based upon the relatedness of the information items. Bournas, on the other hand,

relates to a method for routing internet communications according to key masks in a data structure. Since Yen and Bournas relate to divergent technologies, there is no suggestion in Yen or in Bournas to modify the system of Yen to select context information "based upon a hierarchy of the available context information," as suggested by the Office Action.

On page 9, the Office Action states that the combination of Yen and Bournas would have been motivated by "the benefit of more efficiently searching for contextual information." However, Yen does not teach a desire for more efficient searching of information, instead teaching that information items are to be selected based upon their relatedness. Similarly, Bournas does not suggest that more efficient searching would be desirable in a system such as Yen's. Only impermissible hindsight provides a suggestion to combine these references.

For at least the foregoing reasons, claim 1, and its dependent claims 2, 4, 5, 7, 10, 13, 17, and 18 are patentable over Yen, Bournas, or any combination thereof.

Independent claim 20 relates to a computer program, stored on a computer readable medium, that includes instructions for causing a computer system to, among other things, "make an intelligent selection of selected context information from among the available context information <u>wherein making the intelligent selection comprises selecting the selected context information based upon a hierarchy of the available context information</u>" (emphasis added). For at least the reasons discussed above with respect to claim 1, independent claim 20, and its dependent claims 21-24, are patentable over Yen, Bournas, or any combination thereof.

35 U.S.C. § 103(a) Yen/Matthews Rejection

Claims 3, 8, and 9 have been rejected under 35 U.S.C. § 103(a) as being obvious over Yen in view of Matthews (U.S. Patent No. 5,654,748). For at least the following reasons, Applicants respectfully request withdrawal of this rejection.

Claims 3, 8, and 9 depend from claim 1 and are allowable for the reasons discussed above with respect to claim 1. Matthews also does not remedy the deficiencies of Yen discussed above with respect to claim 1. In particular, Matthews does not describe or suggest, nor is it relied upon to teach, at least the claimed "making an intelligent selection [by] selecting the selected context information based upon a hierarchy of the available context information." Rather,

Matthews relates to a system for providing an electronic programming guide that includes TV schedules and information about a TV program being viewed. For at least these reasons, claims 3, 8, and 9 are patentable over Yen, Matthews, or any combination thereof.

35 U.S.C. § 103(a) Yen/Feinleib Rejection

Claim 6 has been rejected under 35 U.S.C. § 103(a) as being obvious over Yen in view of Feinleib (U.S. Patent No. 6,637,032). For at least the following reasons, Applicants respectfully request withdrawal of this rejection.

Claim 6 depends from claim 1 and is allowable for the reasons discussed above with respect to claim 1. Feinleib also does not remedy the deficiencies of Yen discussed above with respect to claim 1. In particular, Feinleib does not describe or suggest, nor is it relied upon to teach, at least the claimed "making an intelligent selection [by] selecting the selected context information based upon a hierarchy of the available context information." Rather, Feinleib relates to a system for synchronizing supplemental content with a television program by using unique data character string in the closed captioning of the television program. For at least these reasons, claim 6 is patentable over Yen, Feinleib, or any combination thereof.

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.
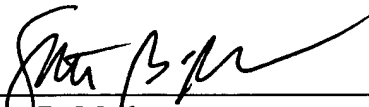
Enclosed is a $250 check for excess claim fees. Please apply any other charges or credits to deposit account 06 1050.

Respectfully submitted,

Date: _Aug. 19, 2005_____

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